



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,772	07/28/2006	Stefan Kuchenhoff	2004P01227WOUS	9890
29177 7590 12/16/2008 BELL, BOYD & LLOYD, LLP P.O. BOX 1135 CHICAGO, IL 60690			EXAMINER JAMA, ISAAK R	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 12/16/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,772	Applicant(s) KUCHENHOFF ET AL.	
	Examiner ISAAK R. JAMA	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/16/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Claims 1-5 has been cancelled earlier.
2. Claims 6-19 has been amended.
3. Claim 22 has been added.
4. Applicant's arguments with respect to claims 6-21 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 8 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Amended claim 8 recites "The distribution device as claimed in claim 6, wherein the control device buffers the short message for the subscriber if the registration device indicates that packet switched network access and circuit switched network access are not available, the interrogation device submits a new request to the registration device at regular intervals, and the control device forwards the short message to the subscriber as soon as the registration device indicates that the

subscriber has at least one of packet switched network access and circuit switched network access". The underlined limitation in the claim whereby the control device buffers the message when it ascertains that both the circuit-switched and the packet-switched networks are unavailable cannot be found anywhere in the application. The closest recitation in the specification is where it recites "If the subscriber is not active, the distribution center can buffer the MMS and ask the registration entity at regular intervals whether the status has changed or if possible send the MMS via the circuit-switched network (PSTN) to the STB", Which is found on page 1, paragraph 0010.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 6-7, 9-10, 12, 13, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application publication Number 2003/0069934 (Garcia-Martin et al.) in view of U.S. Patent application Publication Number 2003/0229722 (Beyda).
2. Regarding claims 6 and 10, Garcia-Martin teaches a distribution device for distributing short messages **[Figure 3, # 6, Instant messaging and presence server]** to an IP-compatible terminal **[Figure 3, #8]**, comprising: a receiving device, which receives a short message in transmission to a subscriber at a first time; an interrogation

device in communication with the receiving device, wherein at a second time after the first time, the interrogation device requests from a registration device via a first network **[Figure 3, # 4, Instant messaging and present agent, page 2, paragraph 0040]** a status of the subscriber, the status of the subscriber **[Figure 3, # 4, Instant messaging and present agent, page 2, paragraph 0047]** including a packet switched network access status **[Page 2, paragraph 0025]** and a circuit switched network access status **[Page 2, paragraph 0024]**; and a control device in communication with at least one of the interrogation device and the registration device, wherein the control device evaluates the status of the subscriber and determines to at least one of forward the short message to the subscriber at a third time **[Figure 3, # 6, Instant messaging and presence server, page 2, paragraph 0040]**. In addition, Garcia-Martin teaches that the registration device **[Figure 4, # 101]** includes a first interface **[Figure 4, the connection to SIP server 105]** and a second interface **[Figure 4, the connection to the GSTN 103 via SMS gateway 106]** and that the connection is to a packet switched network via the SIP server and a circuit switched network via the GSTN **[Figure 4]**. But Garcia-Martin fails to teach buffering of the message for sending to the subscriber at a fourth time after the third time. Beyda teaches a method and apparatus for governing processing of an instant message, for example, a user may want any instant message received from friends to be stored for later retrieval or reading **[Page 3, paragraph 0035]**. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the message storing option of Beyda in the communication method

of Garcia-Martin in order to make the message available to the receiving entity for later processing.

3. Regarding claim 7, Garcia-Martin teaches a distribution device wherein the control device forwards the short message to the subscriber over an IP network (i.e. packet-switched) if the result of the registration device reveals that the subscriber is online **[Page 1, paragraph 0003]**.

4. Regarding claim 9, Beyda teaches a distribution device wherein the control device forwards the short message to the subscriber via a circuit switched network if said interrogation reveals that the subscriber is not online **[column 3, paragraph 0036; i.e. the receiver may want the instant message changed via a text-to-speech converter and sent to a telephone number which may be associated with a telephone or a voice-mail box; telephones are associated with a public switched telephone network which is a switched network]**. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the message storing option of Beyda in the communication method of Garcia-Martin in order to make the message available to the receiving entity via other networks.

4. Regarding claim 12, Garcia-Martin teaches a registration device wherein the message is a short message containing text **[Page 1, paragraph 0013]**.

5. Regarding claim 13, Garcia-Martin teaches a registration device according to the message is a multimedia message containing at least one of images and video **[Page 6, claim 5]**.

6. Regarding claim 22, Garcia-Martin further teaches that the registration device includes a second interface that receives the status of the subscriber from the IP-compatible terminal at regular intervals **[Figure 1, IM&P server]**.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia-Martin in view of Beyda and further in view of U.S. Patent Application Publication Number 2004/0158611 (Daniell et al.)

8. Regarding claim 8, Beyda further teaches a distribution device wherein the control device buffers the short message for the subscriber if the interrogation device reveals through the registration device that the subscriber is not online and has no access to a circuit switched network, the control device then submits a new request to the registration device through the interrogation device at regular intervals and forwards the short message to the subscriber as soon as the interrogation device reveals that the subscriber is now online **[column 4, paragraph 0037]**. But, neither Garcia-Martin nor Beyda specifically teach that if the registration device indicates that packet switched network access and circuit switched network access are not available, the interrogation device submits a new request to the registration device at regular intervals, and the control device forwards the short message to the subscriber as soon as the registration device indicates that the subscriber has at least one of packet switched network access and circuit switched network access. Daniell teaches a system for forwarding instant messages to e-mail, whereby the network is a may be any public or private packet-switched or other data network, including the Internet, circuit-switched network, such as a public switch telecommunications network (PSTN), wireless network, or any other

desired communications infrastructure and/or combination of infrastructure [**Page 2, paragraph 0026**], and that If the attempt to forward the message to User2's last IM processing device, i.e., User2's IM processing device #4 is unsuccessful because the processing device is unavailable, an attempt is made to send User1's processing device an E-mail message when User2 has established E-mail forwarding as an option. When a user establishes the forward to E-mail option, the user effectively always appears online [**Page 3, paragraph 0042**]. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the message rerouting option of Daniell in the combined communication methods of Garcia-Martin and Beyda in order to insure the delivery of the message.

5. Claims 11, 14 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia-Martin in view of U.S. Patent Application publication number 2003/0226143 (Michael et al.).

9. Regarding claims 11 and 14, Garcia-Martin has been discussed above with respect to claims 6 and 10, what Garcia-Martin fails to specifically teach is that the subscriber is connected to the system via a set top box communication device generally utilized for media viewing. Michael teaches a method and system for conveying SMS messages via a TV communication infrastructure for receipt by a TV set-top box [**Figure 8, page 1, paragraph 0014**]. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the message delivery option of Michael in the communication method of Garcia-Martin in order to make messages accessible to a user via television interactive systems.

10. Regarding claim 16, Garcia-Martin teaches a system wherein the distribution center at regular intervals communicates with the registration device to determine if the subscriber is on-line in order to send the message to the subscriber via the IP network when the subscriber is on-line **[Figure 3, paragraph 0047]**.

11. Regarding claim 17, Garcia-Martin teaches a system wherein the distribution center further comprises: a receiving apparatus that receives a message to be sent to the subscriber; and an interrogation device for communicating with the registration device to determine whether the subscriber is online or not **[Figure 3, # 4 and # 6; paragraph 0047]**.

12. Regarding claim 18, Garcia-Martin teaches a system wherein the distribution center through the registration device receives an IP address for the subscriber and sends the message via a packet switched IP network to the subscriber **[Page 1, paragraph 0002]**.

13. Regarding claim 19, Michael further teaches a system wherein the subscriber is connected to the system via a set top box communication device generally utilized for media viewing **[abstract]**. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the message delivery option of Beyda in the communication method of Garcia-Martin in order to make the message available to the receiving entity via a different media such as CATV.

14. Regarding claim 20, Garcia-Martin teaches a system according to claim 14, wherein the message is a short message containing text **[Page 1, paragraph 0013]**.

15. Regarding claim 21, Garcia-Martin teaches a system the message is a multimedia message containing images or video or both **[Page 6, claim 5]**.

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia-Martin and Michael as applied to claim 14 above in further view of U.S. Patent Application Publication Number 2003/0229722 (Beyda et al.).

7. Regarding claim 15, Garcia-Martin and Michael has been discussed above with respect to claim 14 above, what Garcia-Martin and Michael fail to specifically teach is that if the subscriber does not have packet switched access, the distribution center buffers the short message until the subscriber obtains packet switched network access. Beyda teaches a distribution device wherein the control device buffers the short message for the subscriber if the interrogation device reveals through the registration device that the subscriber is not online and has no access to a packet switched network, the control device then submits a new request to the registration device through the interrogation device at regular intervals and forwards the short message to the subscriber as soon as the interrogation device reveals that the subscriber is now online **[column 4, paragraph 0037]**. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the message storing option of Beyda in the communication method of Garcia-Martin for the reasons given above.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ISAAK R. JAMA whose telephone number is (571)270-5887. The examiner can normally be reached on 7:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 2617

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/IRJ/

/Lester Kincaid/
Supervisory Patent Examiner, Art Unit 2617